

REMARKS

In the Restriction Requirement, the Examiner stated that Group I was a first specie, Groups II-VI were a second specie, and that the species were mutually exclusive in an intermediate-final product relationship. The Examiner's reasoning for asserting this intermediate-final product relationship was that if the intermediate product is useful to make other than the final product, and the species are patentably distinct, then there is no single general invention concept. The Examiner further stated that the intermediate product (Group I) is deemed to be useful as a tool, and the inventions are deemed patentably distinct since there is nothing in the record to show them to be obvious variants.

Applicants respectfully traverses this Restriction Requirement. Group I includes independent claims 1, 8 and 13. Claim 1 claims a tungsten carbide coating. Claim 8 claims a dual layer coating including an external layer containing a tungsten carbide. Claim 13 claims a process for producing tungsten carbide by chemical vapor deposition. Groups II-VI include independent claims 31, 51, 56, 70, 76 and 81. Claims 31 and 70 claim processes for the deposition of coatings consisting of two layers, the external layer including a tungsten carbide. Claims 51, 56, 76, and 81 claim a material with at least a coating including a tungsten carbide.

As for the Examiner's assertion that the intermediate product is deemed to be useful as a tool, this statement is believed to be in clear error. The invention of Group I as stated above claims a composition of matter for claims 1 and 8, and the process for producing tungsten carbides in claim 13. These inventions are not tools, and are not intermediate products. Although the claimed coatings could be used on tools, the inventions are not tools. As for the Examiner's statement that the inventions are deemed patentably distinct since there is nothing in the record to show them to be obvious variants, it is also believed that this statement is in error. In U.S.

Restriction practice, the general presumption is that species are usually independent. However, there is no *per se* rule, and the Examiner must analyze the claimed inventions to provide support showing the species are independent. In MPEP Section 806.04(b), a discussion is provided which indicates that species may actually be related inventions; therefore, restriction is improper. The third paragraph of this Section states :

“As a further example, species of carbon compounds may be related to each other as intermediate and final product. Thus, these species are not independent and in order to sustain a Restriction Requirement, distinctness must be shown. Distinctness is proven if it can be shown that the intermediate product is useful other than to make the final product”.

As noted above, the claimed inventions are not simply intermediate and final products. In fact, no intermediate products are claimed at all. What is claimed are coatings including tungsten carbide and processes for creating the tungsten carbide coatings. The technical aspect or feature which links the claims is tungsten carbide as a composition of matter, or a process which is used to make a coating including tungsten carbide.

Because the specific example in the MPEP actually indicates that the present invention does not include independent species, the Restriction Requirement should be withdrawn.

Respectfully submitted,

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